

Appl. No. 10/657,034
Amendment D
September 5, 2003

Remarks

Applicants request consideration on the merits of the above-referenced patent application.

I. Amendments to the Claims

This Amendment D cancels claims 389, 391, and 392. Thus, claims 122-136, 198-224, and 380-388, 390, and 393 are pending. Claims 380, 383, 385-388, and 390 have been amended. All the claims, including the amendments, are shown in the previous section. Applicants submit that the amendments do not introduce any new matter. Specifically:

Applicants have amended claims 380, 388, and 390 in accordance with their election in response to the Examiner's July 15, 2004 telephonic restriction requirement. These amendments are discussed in more detail below.

Applicants have removed the "preventing" and "pre-disposed" language from claims 380, 386-388, and 390. This amendment clarifies the claims because it removes a redundancy, given that "treating" encompasses "preventing". More specifically, "preventing" a condition means reducing the risk of (or delaying the onset of) the condition in a subject pre-disposed to having the condition. See Applicants' specification, page 183, paragraph 725. Such a pre-disposition is itself part of the pathological condition. Thus, "preventing" falls within "treating". This amendment simply rephrases the claims, and does not affect their scope. Thus, it is permissible under MPEP §2163.07.

Applicants have made editorial amendments to claims 380, 383, and 385 to make the claim language more uniform. These amendments simply rephrase the claims, and do not affect their scope. Thus, they are permissible under MPEP §2163.07.

II. Summary of July 15, 2004 Telephone Call and Response to Further Restriction Requirement

The Examiner and Undersigned discussed the claims during a July 15, 2004 telephone call. During that call, the Examiner acknowledged the allowability of claims 122-136 and 198-224. The Examiner, however, indicated that she was requiring further restriction of the method-of-treatment claims (*i.e.*, claims 380-392). Specifically, the Examiner split the subject matter of those claims (as amended by Amendment A) into two groups:

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- I. Group I encompasses methods of treatment encompassed by claims 383, 385, 386, 387, 389, and 391.
- II. Group II encompasses methods of treatment that are encompassed by claims 380, 388, and 390, but falling outside of Group I.

Applicants elect Group I without traverse, and have amended the claims accordingly.

During the same call, the Examiner also requested that the "preventing" and "pre-disposed" language be removed from claims 380, 386-388, and 390. As noted above, this language has been removed.

Finally, the Examiner requested a background article discussing a general link between MMP activity and various diseases listed in the claims. Applicants have enclosed one such article, *i.e.*, Woessner, Jr., J.F., "The Matrix Metalloprotease Family," *Matrix Metalloproteases*, pp. 1-14 (Academic Press, San Diego, CA, Eds. Parks, W.C. & Mecham, R.P. (1998). This article is cited in Applicants' specification in Paragraph 5 on page 2, and also was enclosed with Applicants' September 26, 2003 Information Disclosure Statement (cited as Ref. No. 60). Applicants are happy to provide the Examiner with additional background references upon request.

Applicants and the Undersigned thank the Examiner for her courtesy during the call.

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Applicants submit that the pending claims are in condition for allowance. Applicants do not believe that they owe any fee in connection with this filing. If, however, Applicants do owe any such additional fee(s), the Commissioner is hereby authorized to charge the fee(s) to Deposit Account No. **08-0750**. In addition, if there is ever any other fee deficiency or overpayment under 37 C.F.R. §1.16 or 1.17 in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. **08-0750**.

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The Examiner is requested to call the undersigned if any questions arise that can be addressed over the phone to expedite examination of this application.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE

I certify that this **Amendment D** is being sent via facsimile to (571) 273-0682 to the attention of **Examiner Zinna Northington Davis, Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450** on July 15, 2004.



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